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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/022,939	12/18/2001	Richard L. Kendall	19963YDB	4386

210 7590 08/04/2003

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EXAMINER

KAUFMAN, CLAIRE M

ART UNIT	PAPER NUMBER
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1646

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DATE MAILED: 08/04/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

<p align="center"><b>Office Action Summary</b></p>	<b>Application No.</b> 10/022,939	<b>Applicant(s)</b> KENDALL ET AL.	
	<b>Examiner</b> Claire M. Kaufman	<b>Art Unit</b> 1646	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 12/18/01.
- 2a) ☐ This action is FINAL.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-46 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-46 are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 11 April 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
     If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
     a) ☐ All    b) ☐ Some    \* c) ☐ None of:  
         1. ☐ Certified copies of the priority documents have been received.  
         2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
         3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
     \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
     a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                             | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____  |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)         | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other:  |

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**DETAILED ACTION**

The preliminary amendment filed 12/18/01 to the first line of the specification has been entered.

***Election/Restrictions***

- 5
- I. Claims 1-11, 15, 18-23, 26-31, 35, 36 and 38-40, drawn to nucleic acid, vector and host cell, classified in class 435, subclass 69.1.
- II. Claims 12-14, 16, 17, 24, 25, 32-34 and 37, drawn to protein and fragment thereof and membrane fraction containing the protein, classified in class 530, subclass
- 10 350.
- III. Claim 41-46, drawn to bioassay for identifying an agonist or antagonist, classified in class 435, subclass 7.2.

The inventions are distinct, each from the other because of the following reasons:

15 The nucleic acid of Invention I is related to the polypeptide of Invention II by virtue of encoding the same. The nucleic acid has utility for the recombinant production of the polypeptide in a host cell. Although the nucleic acid and polypeptide are related since the nucleic acid encodes the specifically claimed polypeptide, they are distinct inventions because the polypeptide product can be made by another and materially different process, such as by synthesis or purification from the natural source. Further, the nucleic acid may be used for

20 processes other than the production of the polypeptide, such as for a nucleic acid hybridization assay to identify structurally related nucleic acids.

Inventions I and III are related in view of the nucleic acid encoding the protein used in the method of Invention III. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with

25 another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). The nucleic acid itself cannot be used in the method of Invention III and can be used in another materially different method such as in hybridization to identify structurally related nucleic acids.

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Invention II is related to Inventions III as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP  
5 § 806.05(h)). In the instant case the protein may be used for another materially different purpose other than for identification of an agonist or antagonist, such as in the production of cognate antibody or in the affinity purification of natural ligands.

Because these inventions are distinct for the reasons given above, have acquired a separate status in the art as shown by their different classification and because of their  
10 recognized divergent subject matter, and the search required for each Invention is not coextensive with another, restriction for examination purposes as indicated is proper.

A telephone call was made to Yang Xu for Mark J. Hand on August 4, 2003, to request an oral election to the above restriction requirement, but did not result in an election being made.

Applicant is advised that the reply to this requirement to be complete must include an  
15 election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the  
20 application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

### *Conclusion*

Any inquiry concerning this communication or earlier communications from the  
25 examiner should be directed to Claire M. Kaufman, whose telephone number is (703) 305-5791. Dr. Kaufman can generally be reached Monday through Thursday from 8:30AM to 12:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Yvonne Eyler, can be reached at (703) 308-6564.


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Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0196.

Official papers filed by fax should be directed to (703) 308-4242. Faxed draft or  
5 informal communications with the examiner should be directed to (703) 308-0294. NOTE: If  
applicant *does* submit a paper by fax, the original signed copy should be retained by the  
applicant or applicant's representative. NO DUPLICATE COPIES SHOULD BE SUBMITTED  
so as to avoid the processing of duplicate papers in the Office. **Please** advise the examiner at the  
telephone number above before facsimile transmission.

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Claire M. Kaufman, Ph.D.



Patent Examiner, Art Unit 1646

August 4, 2003